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### III. REMARKS

#### A. In the Claims

Claims 22 and 30 have been amended herein to add the term "arising from infection by one or more gram-positive bacteria, anaerobic organisms, or acid-fast organisms". (Language added to claims 22 and 30, emphasis added) This term clarifies the term "infective disease," as used in each claim. Basis for this amendment can be found, for example, on page 6, lines 25-32 of the present Specification. Applicant respectfully submits that this amendment does not add any new matter to the application.

#### B. Rejection of Claims 22-30, Under 35 U.S.C. § 112, First Paragraph

Claims 22-30 were rejected, under 35 U.S.C. § 112, first paragraph, as "failing to comply with the written description requirement." The Office Action specifically states that the written description provides "insufficient descriptive support for the generic limitation 'infective disease', which may include diseases caused by agents ranging from bacteria to viruses to fungi to parasites, etc."

Applicant respectfully submits that claims 22 and 30, after amendment as set forth herein are each related to methods of treating or preventing "an infective disease arising from infection by one or more gram-positive bacteria, anaerobic organisms, or acid-fast organisms". (Language of claims 22 and 30, emphasis added) Such infections, and examples thereof, are specifically described on page 6, lines 25-32 of the present specification. Applicant respectfully submits that claims 22 and 30, and all claims which depend from claim 22 (i.e., claims 23-29) comply with the written description requirement, after amendment as set forth herein.

In view of the above, Applicant respectfully requests withdrawal of the rejection of claims 22-30, under §112, first paragraph.

#### C. Rejection of Claims 1-30, under 35 U.S.C. §103(a), over Barbachyn *et al.* (U.S. Patent No. 5,688,792) in view of Hillard (Kalamazoo College Student Paper) and WO 00/18387 (ALCON LABORATORIES, INC., invention by Cagle, *et al.*)

Claims 1-30 were rejected, under §103(a), over Barbachyn *et al.* (a reference already of record) in view of Hillard and WO '387, two references submitted by Applicant in an IDS after issuance of the previous Office Action. Barbachyn *et al.* is cited in the Office Action as

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disclosing "antimicrobial oxazolidinone derivatives, such as linezolid." (Office Action, p. 4). The Office Action goes on to note that Barbachyn *et al.* fails to disclose adding a cyclodextrin compound to any such derivatives to make the composition or to practice the methods of the present invention. *Id.* The Office Action cites Hillard as disclosing that cyclodextrins can be used to enhance the solubility of oxazolidinones. Finally, WO '387 is cited as disclosing that "ophthalmic, otic, and nasal compositions containing oxazolidinones may contain solubility enhancing agents such as cyclodextrins." (Office Action, p. 5, citing WO '387 Abstract, and p. 10, lines 21-25).

In order for a reference to be cited as the basis for a rejection under 35 U.S.C. §103(a), it must constitute prior art, as defined under at least one provision of §102. Applicant respectfully submits that neither of the two secondary references cited in combination with Barbachyn *et al.*, above, is prior art, under any provision of §102.

The first of the two secondary references, Hillard, is a report that was written by a student at Kalamazoo College, describing research conducted at Pharmacia & Upjohn Company in the Fall of 1999. The report had not been published as of the priority date of the present application. Therefore, it cannot be prior art, under §102(b). The contents of the publication were also not publicly known at the time of the priority date of the present application. Therefore, it cannot be prior art, under §102(a). The document itself was only submitted to a professor(s) who was under an obligation to keep the document and its contents confidential. The research results were also described in an oral presentation to professors of Kalamazoo College, in February 2000, at a talk whose attendance was limited to professors under a contractual obligation with Pharmacia & Upjohn Company to keep the contents of the talk confidential, at least until the priority date of the present application. Applicant submits that the remaining provisions of §102 do not apply to this reference.

The second of the two secondary references, WO '387, is an international application filed on 29 September 1999, and published on 6 April 2000. Since this application was published within one year of the earliest priority date of the present application (22 August 2000), it cannot be prior art under §102(b). Since the application was filed prior to the new §102(e) rules going into effect on 29 November 2000, it is only considered prior art as of its publication date. Applicant respectfully submits that this reference is also not prior art under

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§102(a) or (e) because the present inventor conceived of the present claimed invention prior to the publication date of WO '387. As evidence of this fact, Applicant respectfully submits a Declaration Under 37 C.F.R. §1.131, "swearing behind" the publication date of that particular reference.

For reasons set forth above, Applicant respectfully submits that neither of the two secondary references cited in the present Office Action is prior art, under any provision of 35 U.S.C. § 102. Applicant also submits that the subject matter of claims 1-30 would not have been obvious to one of ordinary skill in the art over Barbachyn *et al.* alone, at the time the present invention was made. As was noted in the Office Action, Barbachyn *et al.* fails to teach the addition of any cyclodextrin to an oxazolidinone. Applicant submits, furthermore, that particular reference fails to suggest any such combination, as well. Since neither of the two secondary cited references are prior art, Applicant respectfully traverses the rejection of claims 1-30, under 35 USC §103(a), over Barbachyn *et al.* in view of Hillard and WO '387.

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## II. SUMMARY

For reasons given above, Applicant submits that all of the claims pending in the present case (i.e., claims 1-30) are in condition for allowance, after amendment as set forth herein above. Issuance of all the claims is, therefore, requested. The Examiner is invited to contact the undersigned at the telephone number given below, should she wish to discuss the present amendment and suggest changes to the claims in order to further prosecution of the application.

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